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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
KISS, ERIC B	

ART UNIT	PAPER NUMBER
2122	

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/714,323	AMRO ET AL.	
	Examiner	Art Unit	
	Eric B. Kiss	2122	

-- Th MAILING DATE of this communication appears on the cover she t with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 August 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The reply filed 20 August 2004 has been received and entered. Claims 1-32 are pending.

Response to Arguments

2. Applicant's arguments filed 20 August 2004 have been fully considered but they are not persuasive.

a. In regard to the new limitations amended to the independent Claims, the rejections above provide new rejections for all Claims with newly amended limitations.

b. In regard to Applicant's arguments on p. 15, last paragraph, through p. 17, first paragraph, as was stated in the previous Office action,

> In regard to the argument that "none of the cited references provide any incentive or motivation supporting the desirability of the combination" on Page 19, lines 7-8, the examiner directs the applicant's attention to the final sentences of all 103 rejections provided above. These sentences are motivational statements for the combination of the cited references, and hence support the desirability of combination. If there are any specific parts of the motivational statements used to combine the references that the applicant finds invalid, the examiner would consider these arguments.

Despite this invitation by the Examiner, Applicant has again failed to specifically point any supposed errors in statements of motivation to combine the references as discussed in the previous rejections (which are also reproduced below). Accordingly, Applicant's arguments, which amount to a general allegation that the rejections are improper, are not persuasive.

Admitted Prior Art

3. If Applicant does not seasonably traverse the well-known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, Applicant is charged with rebutting the well-known statement in the next reply after the Office action in which the well-known statement was made. This is necessary because the Examiner must be given the opportunity to provide evidence in the next Office action or explain why no evidence is required. If the Examiner adds a reference to the rejection in the next action after applicant's rebuttal, the newly cited reference, if it is added merely as evidence of the prior well known statement, does not result in a new issue and thus the action can potentially be made final.

4. The object of the following statement is taken to be admitted prior art:

> A manufacturer of a computer system often sets up Internet boot facilities in order to provide customers of the computer system needed updates of software and hardware components existing on the computer system. [see the unchallenged statement of Official Notice applied in the rejection of claims 8, 17, 24, and 30 in the Office action mailed 8 July 2003]

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1, 2, 8, 10, 11, 17, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reha et al. (U.S. Patent Number 6,282,709) in view of Imai et al (U.S. Patent Number 5,978,590).

In regard to Claims 1, 10, 31, and 32, Reha teaches: (c) displaying on a display of the computer system an icon (Figure 4, item 44); (d) selecting the icon (Column 9, lines 53-55); (e) responsive to selection....boot facility (Column 9, lines 55-59 and lines 10-13). Reha teaches downloading and installing by a user on the computer system (Column 1, lines 63-65) a software product, but does not teach (f) providing to the Internet boot facility a manufacturer ID number identifying the computer system to the internet boot facility, accessing a file corresponding to the ID number, the manufacturer providing a list of additional software, and that the software product is associated with the ID number. Imai, however, does teach providing a computer ID number, and that the ID number identifies products to be downloaded to the client machine (Column 1, lines 57-67 and Column 2, lines 1-7). Although Imai does not specifically teach that the ID number is a manufacturer ID, since the process of downloading and installing software is done at the manufacturer site, the ID can obviously be a manufacturer ID, since this is the ID the manufacturer will recognize when the ID is transmitted to the manufacturer in Figure 6, item 121. Imai teaches accessing a storage unit to search for the corresponding ID number (Column 1, lines 62-64). Information on storage units are often stored in files, since this provides a way to organize data. Finally, Imai teaches that the manufacturer provides a list of additional software (Figure 3, item 32a). Reha also does not teach installing, during manufacture, a sufficient software required to render the computer system operational and capable of connection to the internet, and providing the computer to the user. Imai, however, does teach installing on a

computer system during manufacture software capable of making the computer functional (Column 1, lines 31-47), as well as other software requested by the user. Although Imai does not teach making the computer capable of connection to the Internet, it is likely that a computer, when shipped, will have internet software already installed on it, thus making the computer internet-ready. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to display a icon, select the icon, access an internet boot facility, and download and install by a user a software product as taught by Reha, where a manufacturer ID number is provided to the internet boot facility, accessing a file corresponding to the ID number, the manufacturer providing a list of additional software, and that the software product is associated with the ID number as taught by Imai, since this allows customized downloading of software products based on an ID, and further teach installing, during manufacture, a sufficient software required to render the computer system operational and capable of connection to the internet, and providing the computer to the user, since receiving a fully working computer on arrival means less set up required for the user, and due to the popularity of the internet, an internet-ready computer is also beneficial.

Reha et al. additionally disclose their software update manager as being a Microsoft Windows compatible application program operating on a PC (col. 3, lines 50-56). In order for the disclosed functionality to be realized, the PC system of Reha et al. must be initially booted. Otherwise, the software update manager could not be loaded and executed.

Reha et al. further teaches original user purchased software being authorized for downloading to the system via a secure server (Col. 10, lines 32-37). Therefore, it would have

been further obvious to one of ordinary skill in the computer art at the time the invention was made to include such authorization as a means of provide software only to users who pay for it.

In regard to Claim 2, Reha teaches the 'update' button, which is associated with the software products listed in the 'software components update list box' in Figure 4, in that the update button downloads and installs the software components selected in the 'software components update list box'. Rhea teaches the software product downloaded to an installed on the computer system comprises the associated software product (Column 9, lines 53-59). Claim 11 corresponds directly with Claim 2 and is rejected for the same reasons as Claim 2.

In regard to Claim 8, it is admitted prior art that a manufacturer of a computer system often sets up internet boot facilities in order to provide customers of the computer system needed updates of software and hardware components existing on the computer system. Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to incorporate such an Internet boot facility maintained by a manufacturer of a computer system as a well known means of providing necessary updates to software and hardware components existing on the computer system. Claim 17 corresponds directly with Claim 8 and is rejected for the same reasons as Claim 8.

7. Claims 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reha et al. (U.S. Patent Number 6,282,709) in view of Imai et al (U.S. Patent Number 5,978,590) and further in view of Cheng et al. (U.S. Patent Number 6,151,643).

In regard to Claim 4, Reha and Imai teach the method of Claim 2, but do not teach that the software product was not previously purchased, and further prompting the user to provide payment information to purchase the associated software product. Cheng, however, does teach this transaction (Column 8, lines 44-54). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to perform the steps taught by Reha and Imai, where the software product was not previously purchased, and further prompting the user to provide payment information to purchase the associated software product, as taught by Cheng, since this allows for easy and effective procurement of software. Claim 13 corresponds directly with Claim 4 and is rejected for the same reasons as Claim 4.

8. Claims 5 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reha et al. (U.S. Patent Number 6,282,709) in view of Imai et al (U.S. Patent Number 5,978,590) and further in view of "Mastering Windows 98" by Robert Cowart (hereinafter Cowert).

In regard to Claim 5, Reha and Imai teach the method of Claim 1, but do not teach "prior to the downloading.... associated with the ID number" and "responsive to the selection.... one of the listed software products". Cowart, however, does teach displaying a webpage comprising a list of software products, and responsive to selection of one of the listed software products, downloading and installing on the computer system one of the software products. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to perform the steps taught by Reha and Imai, where a webpage is displayed comprising a list of software products, and responsive to selection of one of the listed software products, downloading and installing on the computer system one of the software products, since this allows for easy

selection and downloading of software products. Claim 14 corresponds directly with Claim 5 and is rejected for the same reasons as Claim 5.

9. Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reha et al. (U.S. Patent Number 6,282,709) in view of Imai et al (U.S. Patent Number 5,978,590) and further in view of "Mastering Windows 98" by Robert Cowart (hereinafter Cowart) and Cheng et al. (U.S. Patent Number 6,151,643).

In regard to Claim 7, Reha, Imai, and Cowart teach the method of Claim 5, but do not teach that the software product was not previously purchased, and further prompting the user to provide payment information to purchase the associated software product. Cheng, however, does teach this transaction (Column 8, lines 44-54). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to perform the steps taught by Reha, Imai, and Cowart, where the software product was not previously purchased, and further prompting the user to provide payment information to purchase the associated software product, as taught by Cheng, since this allows for easy and effective procurement of software. Claim 16 corresponds directly with Claim 7 and is rejected for the same reasons as Claim 7.

10. Claims 3, 9, 12, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reha et al. (U.S. Patent Number 6,282,709) in view of Imai et al (U.S. Patent Number 5,978,590) and further in view of Fritsch (U.S. Patent Number 6,247,130).

In regard to Claim 3, Reha and Imai teach the method of Claim 2, but do not teach that the software product was previously purchased in connection with the computer system. Fritsch,

however, does teach downloading a previously purchased file on to a computer system (Column 6, lines 62-67 and Column 7, lines 1-7). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to perform the steps taught by Rhea and Imai, where the software product was previously purchased in connection with the computer system, as taught by Fritsch, since this allows customers to download a software product at their convenience on a web site, where they previously paid for the software product. Claim 12 corresponds directly with Claim 3, and is rejected for the same reasons as Claim 3.

In regard to Claim 9, Fritsch teaches downloading a previously purchased file on to a computer system (Column 6, lines 62-67 and Column 7, lines 1-7). It would be obvious to download all the files purchased previously, since it is a necessary part of a transaction to receive the goods purchased. If a customer buys a few different softwares, the customer would want to receive all software. Claim 18 corresponds directly with Claim 9 and is rejected for the same reasons as Claim 9.

11. Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reha et al. (U.S. Patent Number 6,282,709) in view of Imai et al (U.S. Patent Number 5,978,590) and further in view of of "Mastering Windows 98" by Robert Cowart (hereinafter Cowart) and Fritsch (U.S. Patent Number 6,247,130).

In regard to Claims 6 and 15, in addition to the disclosure and teachings applied above to claim 5, Reha and Imai do not teach that the software product was previously purchased in connection with the computer system. Fritsch, however, does teach downloading a previously purchased file on to a computer system (Column 6, lines 62-67 and Column 7, lines 1-7).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to perform the steps taught by Rhea and Imai, where the software product was previously purchased in connection with the computer system, as taught by Fritsch, since this allows customers to download a software product at their convenience on a web site, where they previously paid for the software product.

12. Claims 19, 24, 25, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reha et al. (U.S. Patent Number 6,282,709) in view of Craig et al. (U.S. Patent Number 6,266,809) and further in view of Imai et al. (U.S. Patent Number 5,978,590).

In regard to Claims 19 and 25, Reha teaches the user accessing a website comprising an Internet boot facility (Column 9, lines 53-59 and lines 10-13), and downloading and installing by a user on the computer system (Column 1, lines 63-65), but does not teach that the accessing of the website is done on boot-up of the computer. Criag, however, does teach installing software on start up of a computer system (Column 8, lines 10-14). Neither Reha nor Craig teach "providing...a manufacturer ID number...to the Internet boot facility", "downloading...at least one software product...associated with the ID number", accessing a file corresponding to the ID number, or the manufacturer providing a list of additional software. Imai, however, does teach providing a computer ID number, and that the ID number identifies products to be downloaded to the client machine (Column 1, lines 57-67 and Column 2, lines 1-7). Although Imai does not specifically teach that the ID number is a manufacturer ID, since the process of downloading and installing software is done at the manufacturer site, the ID can obviously be a manufacturer ID, since this is the ID the manufacturer will recognize when the ID is transmitted to the

manufacturer in Figure 6, item 121. Imai teaches accessing a storage unit to search for the corresponding ID number (Column 1, lines 62-64). Information on storage units are often stored in files, since this provides a way to organize data. Finally, Imai teaches that the manufacturer provides a list of additional software (Figure 3, item 32a). Furthermore, neither Reha nor Craig teach a manufacturer installing a sufficient software required to render the computer system operational and capable of connection to the internet, and providing the computer system to the user. Imai, however, does teach installing on a computer system during manufacture software capable of making the computer functional (Column 1, lines 31-47), as well as other software requested by the user. Although Imai does not teach making the computer capable of connection to the Internet, it is likely that a computer, when shipped, will have internet software already installed on it, thus making the computer internet-ready. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have a user access a website comprising an internet boot facility as taught by Reha and downloaded and installing a software product by a user, where the accessing is done at start up, as taught by Craig, where a manufactuer ID number is provided to the internet boot facility and the ID number is associated with the software product downloaded, and accessing a file corresponding to the ID number and the manufacturer providing a list of additional software as taught by Imai, since this allows customized downloading of software products based on an ID, and furthermore a manufacturer installing a sufficient software required to render the computer system operational and capable of connection to the internet, and providing the computer system to the user, as taught by Imai, since receiving a fully working computer on arrival means less set up required for the user, and due to the popularity of the internet, an internet-ready computer is also beneficial.

In regard to Claims 24 and 30, it is admitted prior art that a manufacturer of a computer system often sets up internet boot facilities in order to provide customers of the computer system needed updates of software and hardware components existing on the computer system. Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to incorporate such an Internet boot facility maintained by a manufacturer of a computer system as a well known means of providing necessary updates to software and hardware components existing on the computer system.

13. Claims 20 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reha et al. (U.S. Patent Number 6,282,709) in view of Craig et al. (U.S. Patent Number 6,266,809) and further in view of Imai et al (U.S. Patent Number 5,978,590) and Fritsch (U.S. Patent Number 6,247,130).

In regard to Claims 20 and 26, in addition to the disclosure and teachings applied above, Fritsch teaches downloading a previously purchased file on to a computer system (Column 6, lines 62-67 and Column 7, lines 1-7). It would be obvious to download all the files purchased previously, since it is a necessary part of a transaction to receive the goods purchased. If a customer buys a few different softwares, the customer would want to receive all software.

14. Claims 21 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reha et al. (U.S. Patent Number 6,282,709) in view of Craig et al. (U.S. Patent Number 6,266,809) and further in view of Imai et al (U.S. Patent Number 5,978,590) and "Mastering Windows 98" by Robert Cowart (hereinafter Cowart).

In regard to Claims 21 and 27, in addition to the disclosure and teachings applied above, Reha and Imai do not teach "prior to the downloading.... associated with the ID number" and "responsive to the selection.... one of the listed software products". Cowart, however, does teach displaying a webpage comprising a list of software products, and responsive to selection of one of the listed software products, downloading and installing on the computer system one of the software products. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to perform the steps taught by Reha and Imai, where a webpage is displayed comprising a list of software products, and responsive to selection of one of the listed software products, downloading and installing on the computer system one of the software products, since this allows for easy selection and downloading of software products.

15. Claims 22 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reha et al. (U.S. Patent Number 6,282,709) in view of Craig et al. (U.S. Patent Number 6,266,809) and further in view of Imai et al (U.S. Patent Number 5,978,590) and "Mastering Windows 98" by Robert Cowart (hereinafter Cowart) and Fritsch (U.S. Patent Number 6,247,130).

In regard to Claims 22 and 28, in addition to the disclosure and teachings applied above, Reha and Imai do not teach that the software product was previously purchased in connection with the computer system. Fritsch, however, does teach downloading a previously purchased file on to a computer system (Column 6, lines 62-67 and Column 7, lines 1-7). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to perform the steps taught by Rhea and Imai, where the software product was previously purchased in connection with the computer system, as taught by Fritsch, since this allows customers to

download a software product at their convenience on a web site, where they previously paid for the software product.

16. Claims 23 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reha et al. (U.S. Patent Number 6,282,709) in view of Craig et al. (U.S. Patent Number 6,266,809) and further in view of Imai et al (U.S. Patent Number 5,978,590) and "Mastering Windows 98" by Robert Cowart (hereinafter Cowart) and Cheng et al. (U.S. Patent Number 6,151,643).

In regard to Claims 23 and 29, in addition to the disclosure and teachings applied above, Reha, Imai, and Cowart do not teach that the software product was not previously purchased, and further prompting the user to provide payment information to purchase the associated software product. Cheng, however, does teach this transaction (Column 8, lines 44-54). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to perform the steps taught by Reha, Imai, and Cowart, where the software product was not previously purchased, and further prompting the user to provide payment information to purchase the associated software product, as taught by Cheng, since this allows for easy and effective procurement of software.

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Eric B. Kiss whose telephone number is (571) 272-3699. The Examiner can normally be reached on Tue. - Fri., 7:00 am - 4:30 pm. The Examiner can also be reached on alternate Mondays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tuan Dam, can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EBK/EBK
January 4, 2005

TUAN DAM
SUPERVISORY PATENT EXAMINER